95

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/781,132	02/09/2001	Lawrence M. Sherman	07473-033	1690

30623 7590 03/08/2007
MINTZ, LEVIN, COHN, FERRIS, GLOVSKY
AND POPEO, P.C.
ONE FINANCIAL CENTER
BOSTON, MA 02111

EXAMINER	
KOPPIKAR, VIVEK D	
ART UNIT	**PAPER NUMBER**
3626	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/08/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	09/781,132	SHERMAN, LAWRENCE M.	
	Examiner	**Art Unit**	
	Vivek D. Koppikar	3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on 29 December 2006.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 2,10-14,17,20,26,27,29,37,38,40-44,49,79 and 80 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 2, 10-13, 14, 17, 20, 26-27, 29, 37-38, 40-44, 49, 79-80 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

Status of the Application

1. Claims 2, 10-13, 14, 17, 26-27, 29, 37-38, 40-44, 49 and 79-80 have been examined in this application. This Office Action is in response to the "Amendment" and "Remarks" filed on December 29, 2006.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 79-80 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 79 states that the insurance policy provides for payment only upon the occurrence of simultaneous or coincident death of the persons insured by the policy. However, this claim then goes on to that that a portion of the benefit amount is paid upon the confirmation of the first death of the person insured by the policy and the remainder is then paid upon the confirmation of the second death of another person insured by the policy. This limitation is indefinite because if a benefit is paid after the first person has died, but before a second person insured by the policy has died, then how can the claimed insurance policy be a policy wherein a payment to the beneficiaries occurs only upon the occurrence of simultaneous or coincident death? The Examiner interprets this policy as requiring the death of at least two persons before a benefit is paid so it is not clear why a benefit is paid before the death of at least two persons. Appropriate correction and/or clarification is required. For the purposes of examination, the examiner will interpret these claims as meaning that a benefit is only paid to the

beneficiaries upon the death of a second person at the same or substantially the same time as a first person.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claim 2, 10, 11, 14, 17, 20, 26, 27, 29, 37, 38, 40-44,49 and 79-80 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Number 5,845,256 to Pescitelli in view of US Patent Number 6,584,446 to Buchanan and in further view of "Benefits of survivorship life insurance" by William Kistner (hereinafter referred to as Kistner).

(A) As per claims 2, Pescitelli in view of Buchanan and Kistner collectively teach a method for providing a simultaneous or coincident multiple death insurance policy for one person and another person, the method comprising:

identifying the persons as insured parties under the insurance policy (Pescitelli: Col. 13, Ln. 6-15);

obtaining information regarding the persons (Pescitelli: Col. 13, Ln. 6-15);

entering information regarding the persons into a data processing apparatus and determining in the data processing apparatus the eligibility of each of the persons by comparing information received regarding the persons with one or more standards stored in the data processing apparatus (Pescitelli: Col. 3, Ln. 40-50);

entering information related to a benefit amount into the data processing apparatus (Pescitelli: Col. 8, Ln. 27-49);

entering information related to at least one beneficiary of the insurance policy into the data processing apparatus (Pescitelli: Col. 11, Ln. 21-30);

entering information related to a benefit qualification time frame into the data processing apparatus (Pescitelli: Col. 7, Ln. 56-62 and Col. 8, Ln. 1-26); and generating the insurance policy using the data processing apparatus from the information relating to the eligible persons, the benefit amount, the at least one beneficiary, the first physical condition and the benefit qualification time frame (Pescitelli: Col. 4, Ln. 64-67)

Pescitelli does not teach that the insurance policy creates an obligation of an insurer to pay the benefit amount upon the one person assuming the first physical condition: (i) at a time the another person assumes the first physical condition, or (ii) after the another person assumes the first physical condition and within the benefit qualification time frame, however, this feature is well known in the art as evidenced by Buchanan (Col. 3, Ln. 36-48). At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the method of Pescitelli with the aforementioned feature from Buchanan with the motivation of providing an enhanced policy for the long term care expectations for beneficiaries of an insured, as recited in Buchanan (Col. 1, Ln. 65-Col. 2, Ln. 6).

Pescitelli in view of Buchanan do not teach the following features which are taught by Kistner:

determining a death benefit amount based upon a probability of the simultaneous or coincident death of the persons within a benefit qualification time frame, the death benefit amount having a fixed value and being determined independent of other risk exposures of either or both persons and independent of one or more other insurance benefits either or both persons are eligible for (Kistner: Page 2, Paragraph 2);

the confirmation of the occurrence of simultaneous or coincident death of the persons at substantially the same time or within the benefit qualification time frame (Kistner: Page 2, Paragraph 2),

the policy being a stand-alone policy independent in effect from other insurance benefits either or both persons are eligible for (Kistner: Page 1, Abstract). (Note: There is no indication that the policy taught in Kistner cannot be purchased if the insureds already have other policies in their names, individually.)

At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the combined teachings of Pescitelli in view of Buchanan with the aforementioned teachings from Kistner with the motivation of having a means to pay estate taxes on the transfer of a closely held business to a younger family member who plans to keep the business after the owner's death, as recited in Kistner (Page 2, Paragraph 5).

(B) As per claim 10, in the combined method of Pescitelli in view of Buchanan and in view of Manhattan the at least one beneficiary is financially dependent (relative) upon at least one of the persons (Pescitelli: Figure 4G and Col. 11, Ln. 21-30).

(C) As per claim 11, in the combined method of Pescitelli in view of Buchanan and in view of Manhattan the step of obtaining information regarding the persons includes obtaining responses to one or more questions (Pescitelli: Col. 2, Ln. 62-Col. 3, Ln. 14).

(D) As per claim 13, in the combined method of Pescitelli in view of Buchanan and in view of Manhattan the insurance policy includes a term to designate a period of time the insurance policy is effective (Pescitelli: Col. 7, Ln. 56-62 and Col. 8, Ln. 1-26).

(E) As per claims 14, 17, 26-27, 29, 37-38, 40-44, 49 and 79-80 these claims repeat features previously addressed in the rejection of claims 2, 10-11 and 13 and are rejected on the same basis.

Response to Arguments

5. Applicant's arguments filed on December 29, 2006 with respect to the pending have been considered but are moot in view of the new grounds of rejection.

Conclusion

6. Any inquire concerning this communication or earlier communications from the examiner should be directed to Vivek Koppikar, whose telephone number is (571) 272-5109. The examiner can normally be reached from Monday to Friday between 8 AM and 4:30 PM.

If any attempt to reach the examiner by telephone is unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (571) 272-6776. The fax telephone numbers for this group are either (571) 273-8300 or (703) 872-9326 (for official communications including After Final communications labeled "Box AF").

Another resource that is available to applicants is the Patent Application Information Retrieval (PAIR). Information regarding the status of an application can be obtained from the (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAX. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, please feel free to contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sincerely,
VK
Vivek Koppikar
2/24/2007

Carolyn Bleck
Patent Examiner-3626
3/2/07